

REMARKS

This amendment is being filed in reply to the Office Action of July 17, 2006, a non-final Rejection, a reply to which is due, without payment of additional fee or petition for extension of time to respond, by October 17, 2006.

All of the rejected claims 1-4, 6, 7, 12-16 and 20 have been canceled. Each of the newly presented process claims 24 and 35 (dependent on claim 24) contains the limitations of previously-presented process claims 15 and 16 and, in addition, is limited to a process whereby the effects created on the mammalian epidermis as a result of carrying out the process, namely:

- i. a substantial soothing effect;
- ii. deep-cleansed effect as measured by the IFF squeak test;
- iii. a significant itch reduction;
- iv. a substantial tingling effect;
- v. a substantial warming effect;
- vi. a substantial cooling effect;
- and
- vii. a significantly enhanced menthol/medicinal aroma

exist not only during use, but from 1-30 minutes post use.

Newly-presented claim 25 contains additional limitations with respect to the anti-dandruff agent being zinc pyrithione and the cooling sensate material being N-ethyl-p-menthane-3-carboxamide.

Support for the effects existing during use and 1-30 minutes post use exists in the specification as filed at page 9, line 23. Each of the other limitations of newly-presented claims 24 and 25 were set forth in the above-identified application as originally filed.

Accordingly, it is respectfully submitted that newly-presented claims 24 and 25 are not rejectable as containing new matter under 35 USC §132 or 37 CFR §1.121(a)(6).

It is respectfully pointed out to the Examiner in charge of the above-identified application that the aforementioned effects obtained as a result of carrying out the process of newly-presented claims 24 and 25 are stated at page 3, lines 21 and 22 of the above-identified application to be “in a magnitude substantially and significantly greater than if the cooling sensate enhancer were not included in the anti-dandruff...composition”.

In paragraphs 5, bridging page 3 of the Office Action of July 17, 2006, claims 1-4,6,7,12-16 and 20 (now replaced by newly-presented claims 24 and 25) were rejected under 35 USC §103(a) as being unpatentable over Nakatsu et al. (European Published Patent Application 1,121,927 A2) in view of any of Beilharz et al. (U.S.Patent 5,494,675), Rapaport (U.S.Patent 5,730,965) or Michael (U.S.Published Patent Application 2001/0043912 published on Nov. 22, 2001).

The claims are limited to the inclusion of anti-dandruff shampoos in causing the aforementioned effects; and the use of such shampoos containing a specifically-defined class of fragrance components as well as anti-dandruff compositions in the concentration ranges stated is indeed critical. Although Nakatsu et al. discloses a vast array of cooling and warming sensates useful in conjunction with a vast array of body care products including, but not limited to shampoos, Nakatsu et al. has no teaching of the criticality of applicants' process limitations. Indeed, with respect to such a process, if there can be any argument that the Nakatsu et al. disclosure provides an implication of such a process restricted by the stated limitations, such an implication is in the form of a 'shotgun' disclosure. It is well established case law that given the criticality of a specific process restricted by a critical set of limitations, within literally thousands of the possible disclosed processes of Nakatsu et al., such a 'shotgun' disclosure cannot support a rejection based on 35 USC §103(a). Not only (a) does Nakatsu et al. fail to specifically or implicitly disclose the use in the specific body care product: “anti-dandruff shampoos”

of the specific classes of sensates and sensate enhancers to which applicants' invention is limited, namely:

"C₁-C₃ alkyl or dialkyl N-substituted menthane carboxamides as the cooling agents and C₇-C₁₂ alkanolic acid vanillamides as the cooling sensate enhancers",

but, in addition, (b) Nakatsu et al. does not teach, expressly or implicitly, that the effects created on the mammalian epidermis as a result of carrying out the process defined according to newly-presented claims 24 and 25, namely:

- i. a substantial soothing effect;
- ii. a deep-cleansed effect as measured by the IFF squeak test;
- iii. a significant itch reduction;
- iv. a substantial tingling effect;
- v. a substantial warming effect;
- vi. a substantial cooling effect;
- and
- vii. a significantly enhanced menthol/medicinal aroma

exist not only during use, but from 1-30 minutes post use.

Accordingly, it is respectfully submitted that the arguments propounded by the examiner in support of the 35 USC §103(a) rejection cannot properly be applied to the newly-presented process claims 24 and 25, particularly in view of the showing of the advantageous interaction of the anti-dandruff agent with the sensates and the sensate enhancers in order to provide the effects on use and 1-30 minutes post use of:

- i. a substantial soothing effect;
- ii. a deep-cleansed effect as measured by the IFF squeak test;
- iii. a significant itch reduction;
- iv. a substantial tingling effect;
- v. a substantial warming effect;

- vi. a substantial cooling effect;
and
- vii. a significantly enhanced menthol/medicinal aroma.

It is herewith re-stated that not one of the secondary references adds anything to support the use of the Nakatsu et al disclosure in rejecting process claims 34 and 35 based on 35 USC §103(a). Not one of the secondary references cited by the Examiner in charge of the above-identified application provides any clue of an interrelationship between that which is taught by Nakatsu and the secondary reference teachings. Beilharz et al. discloses a method for treating dandruff based on the use of an alkali metal salt of a low molecular weight huminate with no implicit or explicit teaching of the utility of any sensates to be used in conjunction with the Beilharz anti-dandruff compositions. Rapaport teaches the use of an anti-dandruff composition containing chloroxylenol again with no implicit or explicit teaching of the utility of any sensates to be used in conjunction with the Rapaport anti-dandruff compositions. The only relevance to anti-dandruff compounds that the Michael reference, entitled: "HAIR CARE COMPOSITIONS CONTAINING SELECTED FRIZZ CONTROL AGENTS" has appears at page 9, column 2, paragraph 0107 and page 10, column 1, paragraph 0107 where the anti-dandruff compositions such as zinc pyrithione are indicated to be optional ingredients. At page 9, paragraph 0105, Michael indicates the use of heating and cooling sensates as "other non-essential ingredients" with no tie-in to anti-dandruff agents. Thus, it is again respectfully submitted that the disclosure by the Michael reference of the use of the sensates, ethyl menthane carboxamide as well as trimethyl isopropyl butanamide (at the end of paragraph 0105) cannot be properly applied to the Nakatsu et al. disclosure in order to support a 35 USC §103(a) obviousness rejection.

Claims 1-4,6,7,12-16 and 20 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al. (WO 99/39683), supplied by the Applicant, in view of Nakatsu et al. (EP 121 927).

The Examiner states that Hu et al. discloses an anti-dandruff shampoo compositions comprising from about 0.1% to about 10% by weight of an antimicrobial compound, which acts as anti-dandruff agent, and from about 0.01% to about 5% by

weight of a cool-feeling agent. The Examiner states the cool-feeling agents of Hu et al. include carboxamides such as N-substituted-p-methane-3-carboxamide. See p. 18, lines 21-29. The Examiner states that Hu et al. does not teach the cooling sensate enhancer material does not teach the claimed cooling sensate enhancer materials.

There exists no teaching, motivation or suggestion to combine the references of Hu et al. and Nakatsu et al. Furthermore, even if combinable, Nakatsu fails to cure the deficiencies of Hu et al. for the reasons stated clearly above.

The foregoing amendments and discussion are respectfully urged to be fully responsive to the Office Action of July 17, 2006 and places this case in condition for allowance.

Accordingly, an early action and allowance of the above-identified application are respectfully solicited.

Respectfully submitted,

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